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08/874,781 06/13/97 JOHNSON

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EXAMINER

QM12/1220

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LEWIS, A

ART UNIT

PAPER NUMBER

3761

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*52*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
**08/874,781**

Applicant(s)

**BRUCE C. JOHNSON**

Examiner  
**AARON J. LEWIS**

Group Art Unit  
**3761**



☒ Responsive to communication(s) filed on Nov 28, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

☒ Claim(s) 2-7, 16, 21, and 23-48 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 2, 4-7, 16, 21, 23, 27-31, 39, and 41-44 is/are allowed.

☒ Claim(s) 3, 24-26, 32-34, 36-38, 40, and 45-48 is/are rejected.

☒ Claim(s) 35 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 11/28/2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/874,781 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3,24,2636,47 are rejected under 35 U.S.C. 102(b) as being antipated by Iriarte (Spanish patent 289561), for the reasons ser forth in the office action dated 10/28/98.

As to claims 3,26,36,47, the body (2) is readable upon the flexible truss and the elastic strip (1) is readable upon the resilient member. The body (2) and elastic strip (1) as illustrated in figs.2,3 include a segment devoid of adhesive and which bridges a patient's nose between opposited ends of the body which adhere to outer wall tissues of a patient's nostrils (fig.2D) which is readable upon an intermediate segment.

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Specifically with respect to the amendments to claim 3 in the amendment received 11/28/2000, the adhesive substance on a surface of the resilient member (1) of Iriarte is oriented at least in part the same way as are said first and second end regions to have said adhesives thereat available to engage the outer wall tissues. That is, the adhesive which binds the resilient member (1) and body (2) is the same adhesive which is employed to engage the outer wall tissues; therefore, it (the adhesive) is "oriented at least in part the same way as the first and second end regions" of the nasal dilator of Iriarte.

As to claim 24, figs. 2A-D and fig.3 of Iriarte illustrate a resilient band (1) oriented substantially parallel to a longitudinal extent of the truss (2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 32-34,45; 37-38,46; 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iriarte.

As to claims 32,38, Iriarte, page 5, lines 9-14 discloses that portion of the surface of the body (2) which extends beyond the area of the resilient member (1) includes an adhesive for engaging a patient's outer wall tissues. Figs.2A-D and fig.3 illustrate a substantial portion of that side of the body which engages a patient's outer wall tissues and readable upon the intermediate section as

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discussed above, being covered by resilient member (1); therefore, it would have been obvious that a substantial portion of the intermediate section is not adhesively engaged with a patient's outer wall tissues.

As to claim 33, the resilient member (1) of Iriarte is placed adjacent a first side of the flexible strip of deformable material (2).

As to claims 34,37, while Iriarte discloses a singular resilient member (1), it would have been obvious to replicate the resilient member of Iriarte by mere duplication of an existing structural element. See *In re Harza*, 124 (USPQ) 378 (CCPA 1960); *St. Regis Paper Co., v. Benis Co., Inc.*, 193 USPW 8, 11 (7th Cir. 1977).

As to claims 45,46,48, while Iriarte is silent as to the composition of the material of the truss (1), it is submitted that it would have been obvious to make the truss of Iriarte of any well known material including plastic as an obvious matter of design choice with no new or unobvious results accruing.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iriarte as applied to claims 32-34,45; 37-38,46; 48 above and further in view of Shippert ('402).

The difference between Iriarte and claim 25 is first and second release liners covering the adhesive substances on the first and second end regions of the flexible strip material.

Shippert, in an adhesively coated nose splint, teaches first and second release liners covering the adhesive substances on the first and second end regions of the flexible strip material for protecting the adhesive material prior to use.

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It would have been obvious to modify the flexible strip of Iriarte to employ any well known means for protecting the adhesive material prior to application to a patient's nose including the use of first and second release liners covering the adhesive substances on any portion of the flexible strip including on the first and second end regions of the flexible strip material because it would have protected the adhesive prior to use as taught by Shippert.

***Allowable Subject Matter***

7. Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 2,4-7,39; 16,41; 21,42; 23,27,43; 28-31,44 are allowed.

***Response to Arguments***

9. Applicant's arguments filed 09/27/99 have been fully considered but they are not persuasive with respect to claims 3,24-26,32-34,36-38,45-48.

Applicant's arguments regarding claim 3 are disagreed with because Iriarte does not disclose an adhesive on the surface of the flexible strip (1) which faces a wearer's skin (on the bridge of the nose) during use. Accordingly, that surface constitutes an adhesive void which bridges a wearer's nose.

Applicant's arguments regarding claims 32,36 and 47 are disagreed with because Iriarte discloses an adhesive between the resilient strip (1) and the body (2) on page 5, lines 9-14. The end surfaces (surfaces which in use are adhered to and located on opposite sides of a wearer's

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nose) of the body (2) and strip (1) as illustrated in figs.2(a-d) and fig.3 are shown oriented in the same manner. The fact that there is an overlapping portion of body (2) due to its larger relative size does not exemplify end surfaces which are not oriented in the same manner. Further, the limitation "...said resilient member and said flexible strip of material each being in contact with an adhesive at a surface thereof oriented at least in part as are said end surfaces;..." as recited in claim 47 does not distinguish over the prior art in any manner. The strip (1) and body (2) of Iriarte are disclosed and illustrated as being adhesively connected. The body (2) includes an overlapping portion due to its relatively larger size which includes adhesive for adhering the nasal dilator to a patient's nose. The adhesive between the body and flexible strip of Iriarte is illustrated and disclosed to be "oriented" in all directions in which each of the flexible strip and body are. Accordingly, Iriarte continues to be prior art which is readable upon claims 32,36,47 for the reasons set forth herein above.

10. Applicant's arguments filed 01/31/2000 have been fully considered but they are not persuasive.

Applicant's arguments regarding claim 3 are noted; however, as explained herein above, the language of claim 3 including the amendments of 01/31/2000 do not make clear whether applicant intends to claim the adhesive as an element in combination with the resilient member. The language of claim 3 currently appears to recite an adhesive as an intended result rather than a positive structural element of the claimed combination.

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Applicant's arguments regarding claims 32, 36 and 47 are not persuasive because the adhesive which is recited as being in 'contact with the resilient member at a surface thereof and oriented at least in part as are said end surfaces of the truss', is not defined in any manner which is unobvious over the adhesive which is between the resilient member (1) and body (2) of Iriarte. That is, the adhesive disclosed by Iriarte is oriented at least in part as are the end surfaces of the truss. The placement of an adhesive substance upon the surface of the resilient member which faces a patient's nose and which adheres to a patient's nose in use in addition to an adhesive substance upon the surface of the truss which faces a patient's nose and which adheres to a patient's nose in use has not been defined by the language of these claims. Given the breadth of the language of the claims, Iriarte continues to be appropriately applied as prior art in the manner set forth herein above.

### *Response to Arguments*

11. Applicant's arguments filed 04/25/00 have been fully considered but they are not persuasive.

Applicant's arguments that adhesive being on the resilient member as a distinguishing feature as defined in an amendment to claim 3 are disagreed with. The adhesive of claim 3 on the resilient member is defined in terms of an orientation. The breadth of the language "...oriented at least in part the same way as the adhesives face on said first and second end regions..." encompasses the adhesive which binds body (1) to flexible truss (2) of Iriarte. That is, inasmuch as it (adhesive)



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binds opposing elements together (the body (1) to flexible truss (2) of Iriarte) that adhesive "faces" both towards and away from a user's face during use.

The language "...which surfaces faces directions..." as recited in claims 36 and 47 also encompasses the adhesive which binds body (1) of flexible truss (2) of Iriarte and as stated herein above with respect to applicant's arguments regarding claim 3, the adhesive binds opposing elements together (the body (1) to flexible truss (2) of Iriarte) that adhesive "faces" both towards and away from a user's face during use. Accordingly, applicant's arguments regarding claims 36 and 47 are not persuasive.

Applicant's arguments regarding claims 34 and 37 are disagreed with because it would have been obvious to replicate the resilient member of Iriarte by mere duplication of an existing structural element. See *In re Harza*, 124 (USPQ) 378 (CCPA 1960); *St. Regis Paper Co., v. Benis Co., Inc.*, 193 USPW 8, 11 (7th Cir. 1977).


### *Conclusion*

12. Applicant's amendments to claim 3, filed 11/28/2000 have been fully considered but they are not distinguishing over the prior art of record to Iriarte for the reasons set forth above with respect to claim 3.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Lewis whose telephone number is (703) 308-0716.

Aaron J. Lewis

December 17, 2000

  
Aaron J. Lewis  
Primary Examiner